

**AMENDMENTS TO THE DRAWINGS:**

The attached drawing(s) include changes to FIG. 1 and replaces the original sheet including FIG. 1. In FIG. 1 the second coil set and the active shield coils recited in the claims are represented.

## **REMARKS**

In accordance with the foregoing, claims 1, 2, 6, 7, 8, 15, and 17 are amended. No new matter is added. Claims 1-21 are pending and under consideration.

### **ALLOWABLE SUBJECT MATTER**

Applicants acknowledge with appreciation the indication that claims 17 and 21 recite allowable subject matter. However, since Applicants consider that claim 1, from which claims 17 and 21 depend, defines patentable subject matter, claims 17 and 21 are maintained in dependent form at the present time.

### **OBJECTION TO DRAWINGS**

In the Office Action at item 1, the Examiner objected to the drawings. In order to overcome these objections, a replacement figure is submitted herewith. In replacement FIG. 1, the active shield coil and the second coil set are illustrated. The active shield coil and the second coil set are described in the specification and recited in the claims. Applicants believe that no new matter is added. Approval of replacement figure 1 is respectfully requested.

Relative to claim 4, the active shielding is illustrated in replacement FIG. 1 and supported at least by lines 26-28 in the specification. Relative to claim 8, the second coil set is represented in replacement FIG. 1 and is described at least on page 7 lines 19-25 of the specification. Relative to claim 21, the disk shaped form of the second homogenous region is represented in cross-section as circular region 4 in FIG. 1 corresponding to shaded area 5 of FIG. 2 and described, for example on page 9, lines 29-31 of the specification.

### **CLAIM REJECTIONS UNDER 35 USC §102**

Claims 1-13, 15, 16 and 18-20 are rejected under 35 USC §102(b) as allegedly being anticipated by U.S. Patent No. 5,084,677 to McDougall ("McDougal"). Claims 1-3, 15, 18 and 20 are rejected under 35 USC 102(b) as allegedly being anticipated by U.S. Patent No. 5,717,333 to Frese et al. ("Frese").

McDougall discloses a magnetic field generating apparatus having a first set of coils for generating a first magnetic field in a **(one)** working volume outside the volume defined by the coils and a separate second coil spaced from the first set of coils for generating a second magnetic field in the working volume. The arrangement is such that the resultant magnetic field in the **(one)** working volume is substantially homogeneous. (See McDougall, Abstract.)

Frese discloses a magnet arrangement for a diagnostic magnetic resonance apparatus, including a first and a second unit that operate in combination to generate a substantially homogenous magnetic field in a **(one)** region between the two magnetic field-generating units. (See Frese, Abstract).

Independent claim 1, patentably distinguishes over McDougal and Frese at least by reciting that "coils of the first and second set are constructed and arranged such that under working conditions, **a first homogeneous region can be generated within an envelope defined by the magnet assembly and a second homogeneous region can be generated outside the envelope**, resultant magnetic fields in each of the first and second homogenous region being sufficiently homogeneous to enable a NMR process to be performed on an object in any of the first and second homogenous region." In McDougal and Frese, only one region having a homogenous magnetic field is generated. Therefore, McDougal and Frese fail to teach or suggest every feature recited in claim 1, so that claim 1 and claims 2-21 depending directly or indirectly from claim 1 are patentably distinct over the prior art. Accordingly, Applicants respectfully traverse, and request reconsideration of the rejection based on McDougal and/or Frese.<sup>1</sup>

#### **CLAIM REJECTIONS UNDER 35 USC §103**

Claims 4, 10-14 and 19 is rejected under 35 USC 103(a) as allegedly being rendered obvious by the teachings of McDougall and Frese. Applicants respectfully submit that as argued above McDougall and Frese fail to teach or suggest at least a second homogenous region as recited in claim 1. Thus, claims 4, 10-14 and 19 are patentable at least by inheriting patentable features from independent claim 1.

#### **CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

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<sup>1</sup> See MPEP 2131: "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference," (Citations omitted) (emphasis added). See also MPEP 2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art."

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If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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